

**REMARKS**

Claims 110-137 are pending in this application, with claims 110 and 129 being independent. By this Amendment, claims 110 and 129 are amended to more clearly define the subject matter recited in those claims.

As an initial matter, Applicant takes this opportunity to thank the Examiner for taking time to discuss the outstanding rejections with Applicant's representative during a number of telephone conferences held between early December and late February. During those conferences, referring to several discussions she had with her Supervisory and Primary Examiners, the Examiner provided the reasons for rejection in great detail (to which Applicant does not necessarily agree) and also provided comments for obviating the rejections. In particular, during a telephone conference held on February 29, 2008, the Examiner agreed that Applicant's proposed amendment to at least claim 110 (which is identical to the present amendment to claim 110) would overcome the outstanding rejections applied to claim 110. The Examiner indicated, however, that the proposed amendment would require further search and/or consideration and thus invited Applicant to submit a written response. The following remarks reflect the subject matter discussed during the above-mentioned telephone conferences.

**35 U.S.C. § 102(e) Rejection**

In the Office Action, claims 110-124 and 128-137 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,897,562 to Bolanos et al. ("Bolanos"). For the following reasons, this rejection should be withdrawn.

**Independent Claim 110**

Independent claim 110 is directed to a surgical instrument used in an endoscopic fundoplication. The instrument includes, among other things, an elongated tube having a proximal end and a distal end, and a distal member coupled proximate the distal end of the tube. The distal member includes a rotatable member configured to install at least one fastener and having a connected end and a free end. The rotatable member is configured to pivot between a first position in which the free end is located distally of the connected end and a second position in which the connected end is located distally of the free end. As the Examiner acknowledged during the telephone conference of February 29, 2008, Bolanos does not teach or otherwise suggest the subject matter of amended independent claim 110.

For example, Bolanos discloses a fastening instrument 10 for fastening the lower esophagus to the fundic wall. Instrument 10 includes an elongated body 18 with a fastening assembly 22 on its distal end. Fastening assembly 22 includes a cartridge frame 38 and an anvil 26 pivotally connected to a distal end of cartridge frame 38. A spring 39 biases anvil 26 in an open position, as shown in Fig. 6A, and anvil 26 rotates from the biased, open position to a closed position, shown in Fig. 6B.

The Office Action asserts that elongated body 18 and fastening assembly 22 of fastening instrument 10 allegedly correspond to the recited “elongated tube” and “distal member,” respectively. The Office Action further asserts that anvil 26 of fastening assembly 22 allegedly corresponds to the recited “rotatable member.” Anvil 26, however, cannot correspond to the recited “rotatable member” because, among other reasons, it is not “configured to rotate between a first position in which [its] free end is located distally of [its] connected end and a second position in which the connected end

is located distally of the free end,” as recited in claim 110. Instead, as mentioned above, anvil 26 can only move from the biased, open position shown in Fig. 6A to the closed position shown in Fig. 6B. For at least this reason, as agreed upon during the February 29, 2008 conference, Bolanos does not anticipate the subject matter of independent claim 110.

The Office Action appears to assert, in an alternative, that invagination device 90 and its body portion 92, shown in Figs. 19-28, allegedly correspond to the recited “elongated tube” and “distal member.” The Office Action further asserts that one of tissue clamping members 104 allegedly corresponds to the recited “rotatable member.” As is apparent, however, clamping member 104 cannot correspond to the recited “rotatable member” because, among other reasons, it is not configured to install at least one fastener, as recited in claim 110.

For at least these reasons, independent claim 110 and its dependent claims patentably distinguish from Bolanos.

**Independent Claim 129**

Independent claim 129 is directed to an instrument for folding multiple tissue layers of a body. The instrument includes, among other things, an elongated tube having a proximal end and a distal end, and a distal member configured to fold the multiple tissue layers together. The distal member has a first member having a proximal end coupled to the distal end of the tubular member and a distal end, and a second member rotatably coupled to the distal end of the first member. The instrument further includes a grasper pivotably coupled to one of the distal member and the tube.

The Office Action asserts that elongated body 18, cartridge frame 38, and anvil 26 of Bolanos allegedly correspond to the recited “elongated tube,” “first member,”

and “second member,” respectively. The Office Action further asserts that “ridges on either [cartridge frame] 38 or [anvil] 26” correspond to the recited “grasper.” Without necessarily agreeing with the Office Action’s characterization of Bolanos, Applicant has amended independent claim 129 to recite that the grasper is pivotably coupled to one of the distal member and the tube.

As is apparent, the alleged “ridges” on either cartridge frame 38 or anvil 26 cannot correspond to the recited “grasper” because, among other reasons, they are not pivotally coupled to one of the distal member and the tube, as recited in claim 129. Instead, they are merely “on” cartridge frame 38 or anvil 26.

Moreover, while the Office Action asserts that fastening assembly 22 having cartridge frame 38 and anvil 26 allegedly corresponds to the recited “distal member,” cartridge frame 38 and anvil 26 are neither configured nor intended to fold multiple tissue layers, as recited in independent claim 129. Instead, fastening assembly 22 is only configured to install fasteners to tissue layers that have already been folded, as best shown in Figs. 26 and 27. Therefore, fastening assembly 22 cannot correspond to the recited “distal member” of claim 129.

The Office Action asserts, in an alternative, that invagination device 90 shown in Figs. 19-28 allegedly corresponds to the recited “elongated tube.” The Office Action further asserts that body portion 92 and one of tissue clamping members 104 allegedly correspond to the recited “first member” and “second member.” As is apparent, however, neither body portion 92 nor clamping member 104 is configured to install at least one fastener, as recited in claim 129. Bolanos instead uses fastening assembly 22 (see e.g., Fig. 1) moveably inserted into channels 94 of body portion 92 to install

fasteners. Fastening assembly 22 cannot be considered as part of body portion 92 because it is not coupled to the distal end of the elongated tube, as best shown in Figs. 26 and 27.

For at least these reasons, independent claim 129 and its dependent claims patentably distinguish from Bolanos.

Thus, Applicant respectfully requests reconsideration and withdrawal of this 35 U.S.C. § 102(e) rejection.

### **35 U.S.C. § 103(a) Rejection**

Claims 125-127 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bolanos, in view of U.S. Patent No. 5,403,326 to Harrison et al. ("Harrison").

Without necessarily agreeing to this rejection, Applicant notes that dependent claims 125-127 depend, either directly or indirectly, from independent claim 110. Also, Harrison does not supply the above-discussed deficiencies of Bolanos. Therefore, dependent claims 125-127 should also patentably distinguish from the alleged combination of Bolanos and Harrison at least by virtue of their dependency from independent claim 110. Thus, Applicant respectfully requests reconsideration and withdrawal of this rejection under 35 U.S.C. § 103(a).

### **Conclusion**

In view of the foregoing reasons, Applicant respectfully requests reconsideration of this application, withdrawal of all of the outstanding rejections, and allowance of all pending claims.

The Office Action contains a number of statements and characterizations regarding the claims and the related art. Applicant declines to necessarily subscribe to

any statement or characterization in the Office Action, regardless of whether it is addressed above.

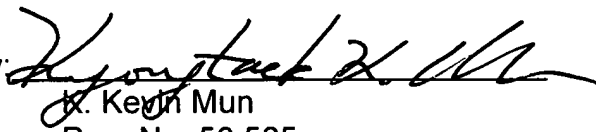
The Examiner is invited to call the undersigned if a telephone conversation might advance prosecution of the application.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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